

REMARKS

In response to the outstanding Office Action, Paper No./Mail Date 10627380, dated July 13, 2005, applicant has carefully studied the references cited by the Examiner and the Examiner's comments relative thereto.

Claim 1 has been amended to correct a typographical error.

New Claims 11-20 have been added to define subject matter to which applicant is entitled.

Claims 1-20 remain in the application for consideration by the Examiner.

No new matter has been added.

Reconsideration of the application, as amended, is respectfully requested.

The Examiner rejected Claims 1-6 under 35 U.S.C. 103(a) as being unpatentable over Eddleman et al. (U.S. Patent No. 4,301,010) in view of Jusaitis et al. (U.S. Patent No 4,859,348). The Examiner stated:

“Eddleman discloses an element comprising a first body having an inlet and outlet, a second body having an inlet and outlet and a filter separator pad, in which second body interconnected with said first body portion. Eddleman also discloses a cylindrical first body portion having an open top and a closed bottom wherein the second body portion is received within the cylindrical wall of first body portion wherein the fluid conduit of second body portion is aligned with first body portion wherein said first and second body portion are interconnected in a fluid-tight relationship and a first body inlet portion that extends for the closed bottom. However, Eddleman fails to disclose a coalescing function for the element as mentioned in claims 1-6. Jusaitis teaches a coalescing filter element. It would have been obvious to one of ordinary skill in the art at the time of the invention to manufacture the Eddleman filter element with Jusaitis coalescing filter element, wherein the arrangement separates a liquid including a coalescer filter, a housing, and a liquid collection arrangement. The Jusaitis invention is responsible for separating oils or hydrocarbons that may pass through the filter element.”

In accordance with the provisions of 35 U.S.C. § 103(a), the Examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. To support a finding of obviousness, the Examiner must “step backward in time and into the shoes worn by the hypothetical ‘person of ordinary skill in the art’ when the invention was unknown and just before it was made”. This element requires that the Examiner refrain from using hindsight when combining prior art references.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation; either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Secondly, there must be a reasonable expectation of success. And finally, the prior art references must teach or suggest all the claim limitations. The

teaching or suggestion to make the claimed combination of design features must be found in the prior art and must not be based on applicant's disclosures.

Claim 1 of the application is directed to a coalescing element for separating water from hydrocarbon fluids.

Eddleman et al. does not show or suggest a coalescing element for liquid/liquid separation as recited in amended Claim 1. Eddleman et al. teaches a filter element used to separate a solid from a liquid. There is no suggestion to modify the structure disclosed in Eddleman et al. to separate liquids from liquids, let alone water from hydrocarbon fuels. Jusaitis et al. discloses a coalescing filter device for separating oils and other immiscible organic liquids from beverages and other consumable liquids. There is no teaching or suggestion in Jusaitis et al. to combine the structure disclosed therein with the solid/liquid separation system disclosed in Eddleman et al. to result in applicant's invention. Absent impermissible hindsight, there is no motivation to combine the references.

Applicant submits that the references do not, singly or in combination, show a coalescing filter element as recited in Claim 1. The Examiner has not factually established a prima facie conclusion of obviousness based on the cited prior art as required by 35 U.S.C. § 103(a). Claims 2-6, which depend either directly or indirectly from Claim 1, along with Claim 1, are deemed to be directed to allowable subject matter.

The Examiner rejected Claims 7-10 under 35 U.S.C. 103(a) as being unpatentable over Eddleman et al (U.S. Patent No. 4,301,010) and Jusaitis et al. (U.S. Patent No 4,859,348), and further in view of Young (U.S. Patent No 4,362,630). The Examiner stated:

"Eddleman as modified by Jusaitis discloses a coalescing filter comprising a first body having an inlet and outlet, a second body having an inlet and outlet and a filter separator pad, in which second body interconnected with said first body portion. However, Eddleman as modified by Jusaitis fails to disclose a coalescing fiberglass separator portion. Young teaches a coalescing element that includes a fiberglass separator portion that is utilized in the filtration process. It would have been obvious to one of ordinary skill in the art at the time of the invention to manufacture Eddleman as modified by Jusaitis invention in view of the teachings of Young, wherein a fiberglass separator pad is an acceptable media of filtration for a hydrocarbon separation process. Young also discloses a disc-shaped coalescing element, formed of a plurality of superposed disc-shaped elements, wherein one of said superposed disc-shaped elements is reinforced by a scrim material."

There is no teaching or suggestion in Young to combine the structure disclosed therein with the solid/liquid separation system disclosed in Eddleman et al. or the system disclosed in Jusaitis et al. to result in applicant's invention. The Examiner has not factually established a

prima facie conclusion of obviousness based on the cited prior art as required by 35 U.S.C. § 103(a). Therefore, Claims 7-10 are not obvious under 35 U.S.C. §103(a), and are patentable.

Reconsideration and withdrawal of the rejection under 35 U.S.C. 103(a) is respectfully requested.

New Claims 11-20 have been added to the application, and define subject matter to which the applicant is entitled. Independent Claim 11 contains the same limitations of Claim 1 as discussed above. Claim 11 further defines applicant's invention to include a second body portion having a fluid conduit with an inlet and an associated outlet, the conduit defined by a hollow upstanding central member adapted to receive a syringe and concentric with the second body portion. Claims 12-20 depend, either directly or indirectly, from Claim 11 and contain the same limitations as Claim 11. None of the references cited by the Examiner discloses a second body portion having a fluid conduit with an inlet and an associated outlet, the conduit defined by a hollow upstanding central member adapted to receive a syringe and concentric with the second body portion. It is submitted that Claims 11-20 properly define applicant's structure and distinguish the same from the prior art of record. Accordingly, these claims are deemed patentable. A formal Notice of Allowance is respectfully solicited.

While the applicants' attorney has made a sincere effort to properly define applicants' invention and to distinguish the same from the prior art, should the Examiner deem that other language would be more appropriate, it is requested that a telephone interview be had with the applicants' attorney in a sincere effort to expedite the prosecution of the application.